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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,467	04/09/2001	Hiroshi Shinoki	JG-SIK-5063/500676.20003	8683

7590 08/22/2002

REED SMITH LLP
375 Park Avenue
New York, NY 10152

EXAMINER
MAUPIN, CHRISTINE L

ART UNIT	PAPER NUMBER
1637	8

DATE MAILED: 08/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/829,467	Applicant(s) SHINOKI ET AL.	
	Examiner Christine L. Maupin	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 July 2002* .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-30* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *Detailed Action* .

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 3, 5, 7, 9, 11, 13, 15, 17, 19, and 27 drawn to fluorescent labeling complexes, classified in class 536, subclass 29.13.

II. Claims 2, 4, 6, 8, 10, 12, 14, 16, 18, 20, and 28 drawn to fluorescent labeling complexes nucleotides, classified in class 536, subclass 25.32.

III. Claims 21, 23, 25 and 29 are drawn to methods of making fluorescent labeled nucleotides, probes and primers, classified in class 532, subclass 557.

IV. Claims 22, 24, 26 and 30 drawn to methods of making fluorescent labeled nucleotides, probes and primers, classified in class 532, subclass 560.

The inventions are distinct, each from the other because of the following reasons:

Inventions of groups I, and the invention of groups II, are unrelated. Inventions are unrelated if it can be shown that they have different modes of operation, different functions, or different effects (MPEP § 806.05). In the instant case the different inventions because the fluorescent labeling complex products, constitute patentably distinct inventions as the physiochemical structure and properties of the dyes will inherently operate distinctly different in the same environment. The dyes of the invention of group I will be operable will have altered functions under different pH conditions, regiosteric conditions, excitation conditions, as well as different solubilities,

and solvent-dye relationships and interactions with each other than the dyes of the invention.

The invention of group I and II and the invention of groups III and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the products of the inventions of groups I and II may be used in excited-state kinetics or quenching methods without being attached to a nucleic acid as in the invention of group III. Further the fluorescent labels for nucleic acids of groups II and I may be attached to nucleic acids with preparations such as photo adduct reactions, or chemical synthesis with disrupted ionic equilibrium with out the process steps of the inventions of group III or IV.

Inventions of groups III, and the invention of groups IV, are unrelated. Inventions are unrelated if it can be shown that they have different modes of operation, different functions, or different effects (MPEP § 806.05). In the instant case the different inventions because the products constitute patentably distinct inventions as the physiochemical structure and properties of the probes and primers will inherently operate distinctly different in the same environment. The probes and primers of the invention of group III will be operable under different pH conditions, regiosteric conditions, excitation conditions, solubilities, as well as solvent-dye relationships and interactions with each other than the probes or primers of the invention of group IV.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Further, because these inventions are distinct for the reasons given above and the search required for each group is not required for another group, therefore restriction for examination purposes as indicated is proper. Applicant is requested to submit a demographic descriptive example of the species election as well as a textual description.

This application contains claims directed to the following patentably distinct species of the claimed invention: The species consisting of the variables: A, B, C, R^1-R^{11}, X, Y, Z, m, AMP, ADP, ATP, GMP, GDP, GTP, CMP, CDP, CTP, UMP, UDP, UTP, TMP, TDP, TTP, 2-Me-AMP, 2-Me-ADP, 2-Me-ATP, 1-Me-GMP, 1-Me-GDP, 1-Me-GTP, 5-Me-CMP, 5-Me-CDP, 5-Me-CTP, 5-MeO-CMP, 5-MeO-CDP, 5-MeO-CTP, –CH_2-, -CH=CH-, -C ≡ C-, -CO-, -O-, -S-, -NH-, deoxynucleotide, dideoxynucleotide.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-30 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call was made to Mr. Goldberg on August 9th, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine L. Maupin; whose telephone number is (703) 308-3617 and fax number is (703) 746-7641.

The examiner is normally in the office between the hours of 9:30 a.m. and 5:30 p.m., and telephone calls either in the morning or the mid-afternoon are most likely to find the examiner in the office.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703) 308-1119.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1234.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission via the U.S.P.T.O. Fax Center located in Crystal Mall 1. The CM1 Fax Center numbers for Technology Center 1600 are either (703) 308-4242 or (703) 308-2724. Please note that the faxing of such papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

August 16, 2002

Christine L. Maupin
Examiner
Art Unit 1637

JEFFREY SIEW
PRIMARY EXAMINER
8/19/02